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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/715,517 | 11/19/2003 | Hidekazu Amamoto | 040894-5977 | 4688 |

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

MORRISON, THOMAS A

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3653

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 10/715,517 | Applicant(s) AMAMOTO, HIDEKAZU | |
| | Examiner Thomas A. Morrison | Art Unit 3653 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-31 is/are rejected.
- 7) ☒ Claim(s) 1-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment dated 07/06/2006 has been entered.

Election/Restrictions

2. Claim 1 contains allowable subject matter. Provided that the objections to claim 1 are overcome, the restriction requirement of species I. to IV., as set forth in the Office action mailed on 7/27/2005, will be reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement will hereby be withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 18-30, directed to species II. to VI. Will no longer be withdrawn from consideration because the claim(s) requires all the limitations of an allowable claim.

Moreover, upon further consideration of claim 31, it has been decided that claim 31 is generic and this independent claim will also be rejoined.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show (1) the recited release operational member of claim 8; (2) the recited contact interlocking member of claim 8; (3) the recited coupling member of claim 8; (4) the recited coupling member of claim 9; (5) the recited gear train of claim 9; (6) the recited contact interlocking member of claim 9; (7) the recited gear train of claim 10; and (8) the recited contact interlocking member of claim 10 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

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informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: (1) the recited "release operational member" of claim 8 should be identified using a reference numeral in the specification, since it is a claimed element; (2) the recited "contact interlocking member" of claims 8, 9 and 10 should be identified using a reference numeral in the specification, since it is a claimed element; (3) the recited "coupling member" recited in claims 8 and 9 should be identified using a reference numeral in the specification, since it is a claimed element; (4) the recited "gear train" recited in claims 9 and 10 should be identified using a reference numeral in the specification, since it is a claimed element. Appropriate correction is required.

Claim Objections

5. Claim 1 is objected to because of the following informalities: (1) "the uppermost" in line 5 of claim 1 should be -- an uppermost --; (2) "an uppermost" in line 7 of claim 1 should be -- the uppermost --; (3) "the change" in line 9 should be -- a change --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, it is unclear what is meant by the recitation, "the elastic support member lifted up by the elastic support member". How can the elastic support member lift itself up?

Claim 20 recites the limitation "the pullout operation" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitation "the pullout operation" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 27, it is unclear what is meant by the recitation, "the return release member acts on the return restraining member **in a state where preparations for feeding the sheets have been completed**". (emphasis added).

Regarding claim 28, the dependency of this claim appears to be incorrect. As currently dependent from claim 21, it is unclear in claim 28 how many different sheet trays are claimed and how many different apparatus bodies are claimed.

Claim 28 recites the limitation "the return release member" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "the return restraining member" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 30, it is unclear how many different engagement members the restraining mechanism has. See the engagement member in claim 1 and the engagement member in claim 30 that depends from claim 1.

Regarding claim 30, it is unclear what is meant by the recitation, "the module of the gear that is the engagement member of the restraining mechanism is set to be smaller than that of the guide gear".

Claim 31 recites the limitation "the elastic force" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation "the uppermost sheet" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation "the change" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 31, it is unclear what is meant by the recitation, "held at a substantial constant" in line 14 of claim 31.

Allowable Subject Matter

7. Claims 1-17 would be allowable if rewritten to overcome the objection outlined above. Claims 18-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claim 31

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would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PATRICK MACKEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600